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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,053	11/19/2003	David Charles Lyons	12929.1123US01	9304
7590 08/30/2005 Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER COCKS, JOSIAH C	
			ART UNIT 3749	PAPER NUMBER

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,053

Applicant(s)

LYONS ET AL

Examiner

Josiah Cocks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16 and 51 is/are allowed.
- 6) ☒ Claim(s) 17, 18, 24-26, 29-36 and 38-50 is/are rejected.
- 7) ☒ Claim(s) 19-23, 27, 28 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date various.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements filed 2/28/2005 and 5/19/2005 have been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 29, 30, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,782,231 to Wade (“Wade”).

Wade discloses in Figures 1-7 the invention as described in applicant’s claims 29, 30, and 32-34. In particular, Wade shows a heating appliance having a combustion chamber enclosure having the structure described (54), and an outer air enclosure (10) having the structure described, including extending at least partially around an outer surface of the first and second side panels of the combustion chamber enclosure and (see Fig. 2).

In regard to the limitation that the air enclosure carries “combustion air,” this is simply a statement of the intended use of the air. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

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capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the outer enclosure of Wade would be capable of carrying combustion air and meets all the structural limitations of applicant's claims combustion air enclosure and therefore meets applicant's claims. Further, any hole formed in any of the rear, first and second side panels would provide an inlet for air that would be suitable for combustion.

4. Claims 38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,542,407 to Hawkinson ("Hawkinson '407").

Hawkinson '407 discloses the invention as described in applicant's claims 38. In particular, Hawkinson '407 shows in Fig. 3 a method of assembling a fireplace including the step of positioning the combustion chamber (118) inside a combustion air enclosure and securing a glass panel (122) to the combustion chamber enclosure (note chambers 124).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,138,667 to Cakebread ("Cakebread") (previously cited) in view of U.S. Patent No. 6,378,516 to Blount ("Blount").

Cakebread discloses in Figures 1-8 the invention similar to that described in applicant's claims 17 and 18. In particular, Cakebread discloses a heating appliance including a combustion chamber enclosure (22) having top, bottom and side panels (see Fig. 3), an outer enclosure (12), and fireplace controls in the form of a gas valve and control unit attached to the bottom surface of a bottom panel (34) and disposed within the outer enclosure (see Figs. 2 and 4). Cakebread also discloses a combustion air enclosure (44) between the combustion chamber enclosure and the outer enclosure (see Fig. 2). In regard to the method claims 17-22 and 28, Cakebread is considered to disclose the method of manufacturing recited in these claims including coupling a glass panel (40) to the front surface of the combustion chamber enclosure (see Fig. 3), and matching the patterns of the side panel and the combustion chamber enclosure (see Fig. 3).

Cakebread does not disclose positioning the controls between the outer enclosure and one of the side panels.

Blount teaches a heating appliance that includes an outer enclosure (shown in phantom) and an inner enclosure (12). Controls (e.g. switch 36 and valve 44) for a gas burner assembly are

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positioned between the outer enclosure and a side panel of the inner enclosure to provide for easy access to the controls (see col. 2, lines 58-60).

Therefore, in regard to claims 17 and 18 it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the heating appliance of Cakebread to incorporate the side location for controls as taught in Blount to desirably provide easy access to these controls (see col. 2, lines 58-60).

8. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread and Blount as applied to claim 17 above, in view of U.S. Patent Application Publication 2003/0019490 to Buffington ("Buffington").

Cakebread discloses all the limitations of claim 23 except that the side and read portions include a contoured surface to create an appearance of no back corners.

Buffington teaches a fireplace in the same field of endeavor as Cakebread. In Buffington, the fireplace is shown as arched (see Fig. 3). The examiner considers this arched surface to be the contoured surface as recited in applicant's claims.

Therefore, in regard to claim 23, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the fireplace of Cakebread to incorporate the arched surface of Buffington as this produces a rounded contour that is aesthetically pleasing (see Buffington, col. 1, paragraphs 0005 and 0035).

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9. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, and Blount as applied to claims 17 above, in view of U.S. Patent No. 6,170,481 to Lyons et al. (“Lyons”).

Cakebread teaches all the limitations of claims 24-26 except possibly that the combustion chamber is molded or specifically formed from compression, injection, or vacuum molding forming a continuous panel using a ceramic fiber and a binder or a moldable ceramic.

In regard to claim 26, applicant did not dispute the assertion in the prior Office action of official notice as to the use of a brick design in a fireplace combustion chamber. Accordingly, a brick design is considered to be admitted prior art. Further, applicant also did not dispute the alternative application of design choice in selecting a particular design, such as brick, for a combustion chamber. Accordingly, and alternatively, such a brick design is maintained as being merely a matter of aesthetic design choice.

Lyons teaches a fireplace in the same field of endeavor as Cakebread. In Lyons, the combustion chamber of the fireplace is formed from vacuum molding as a continuous panel using a ceramic fiber and a binder (RCF material) (see Lyons, col. 9, lines 42-63).

Therefore, in regard to claims 24-26, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combustion chamber of Cakebread to be vacuum molded forming a ceramic fiber with binder panel as vacuum molding is understood in the art to produce a rigid fireplace box (see Lyons, col. 9, lines 60-63) and a ceramic fiber and binder material is recognized to have desirable insulating properties with cost advantages (see Lyons, col. 6, lines 28-35).

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10. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wade as applied to claim 29 above.

In regard to claim 31, while Wade shows an air opening (98) in the combustion chamber enclosure, the reference possibly does not disclose a plurality of openings. However, the mere duplication of a known part has no significance unless a new or unexpected result is produced. (See MPEP 2144.04(VI)(B)). Accordingly, providing an additional or plurality of air openings is not regarded as patentably distinct.

11. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade as applied to claim 29 above, and further in view of U.S. Patent No. 6,170,481 to Lyons et al. ("Lyons").

Wade teaches all the limitations of claims 35 and 36 except possibly the combustion air enclosure is molded as a single piece or includes panels formed as a single piece.

Lyons teaches a fireplace in the same field of endeavor as Cakebread. In Lyons, the combustion chamber of the fireplace is formed from vacuum molding as a single piece using a ceramic fiber and a binder (RCF material) (see Lyons, col. 9, lines 42-63).

Therefore, in regard to claims 35 and 36, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combustion chamber of Wade to be vacuum molded forming a ceramic fiber with binder panel as vacuum molding in a single piece is understood in the art to produce a rigid fireplace box (see Lyons, col. 9, lines 60-63) and a ceramic fiber and binder material is recognized to have desirable insulating properties with cost advantages (see Lyons, col. 6, lines 28-35).

12. Claims 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, as applied to claim 1 above, in view of U.S. Patent No. 4,913,131 to Peterson ("Peterson").

Cakebread discloses all the limitations of claims 8, 16, and 39-43, including a glass panel (40) with a glass frame and glass sheet (see Fig. 3), except possibly for a surround member or access panel with first and second side panels.

Peterson teaches a fireplace in the same field of endeavor as Cakebread. In Peterson, the fireplace includes a surround member/access panel (see Fig. 3) with first and second side panels (43 and 44).

Therefore, in regard to claims 39-43, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the fireplace of Cakebread to incorporate the surround member of Peterson as this member desirably provides a decorative front facing (see Abstract of Peterson).

13. Claims 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,542,407 to Hawkinson ("Hawkinson '407").

Hawkinson '407 discloses in Figs. 1-3 an invention similar to that described in applicant's claims 44-50. In particular, as shown in Fig. 3, at least two panels of the combustion chamber enclosure (118) are surrounded by the combustion air enclosure. Applicant's claims do not specify what constitutes a "side" panel. Accordingly, in Fig. 3 one of the panels (122) may be considered a rear panel, and one may be considered a side panel, thereby meeting applicant's

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claim limitations of a combustion air enclosure that partially surrounds at least one side panel and a rear panel of the combustion chamber enclosure.

In regard to the recitation, that no viewing is provided through the side and rear panels, this is not regarded as patentably distinguishing over Hawkinson '407. It has been held that the elimination of an element and its function is obvious if the function of the element is not desired. See MPEP 2144.04(II)(A). In this case, while Hawkinson '407 does provide that the panels (122) are made of glass and thus are capable of providing viewing, if viewing through these panels is not desired a person of ordinary skill in the art would reasonably make these panels out of a material that does not allow for viewing.

Allowable Subject Matter

14. Claims 1-16 and 51 are allowed.

15. Claims 19-21, 22, 23, 27, 28, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

16. Applicant's arguments filed 6/21/2005 regarding the claims not noted under the Allowable Subject Matter section above have been fully considered but they are not persuasive. In particular, applicant argues that Hawkinson '407 does not show a combustion air enclosure as

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claimed. However, as noted above, Hawkinson '407 unambiguously shows providing a combustion air enclosure, which includes the combustion air chambers (124) shown in Figure 3.

Applicant's remaining arguments are considered to be addressed in the rejections noted above, including those based on the newly recited references to Wade and Blount. However, the examiner specifically notes applicant's comments from page 17 of the response pertaining to claim 29 and the alleged lack of a showing by the examiner of "forming a hole through any of the first and second side panels..." (see page 17, first paragraph). This argument is irrelevant to the patentability of claim 29, as claim 29 does not require that a hole be formed. This claim merely recites in the whereby clause that were any hole to be formed an inlet for combustion air would be provided. This is not a positive recitation of forming a hole for inlet air. As noted above, Wade discloses all the positively recited structure of claim 29.

Accordingly, the claims not noted under the Allowable Subject Matter section are not considered to patentably distinguish applicant's claims over the prior art of record.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on weekdays from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter, can be reached at (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Any questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

jcc
August 25, 2005


JOSIAH COCKS
PRIMARY EXAMINER
ART UNIT 3749